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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

41286

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Application Number

10/023,990

Filed

December 21, 2001

First Named Inventor

John Seibel et al.

Art Unit

2177

Examiner

Kuen S. Lu

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒

attorney or agent of record.

46,300

Registration number _____

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Christian C. Michel

Typed or printed name

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Telephone number

August 9, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.☒*Total of 1 forms are submitted.

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PATENT
Case Docket No.: 41286

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|--------------------------|---|------------------------|
| In re Application of: | : | |
| | : | |
| John Seibel, et al. | : | Confirmation No.: 8142 |
| | : | |
| Serial No.: 10/023,990 | : | Group Art Unit: 2177 |
| | : | |
| Filed: December 21, 2001 | : | Examiner: Kuen S. Lu |
| | : | |
| For: AUTOMATED VOTER | : | |
| REGISTRATION AND | : | |
| TABULATION SYSTEM | : | |

ARGUMENTS IN SUPPORT OF PRE-APPEAL

BRIEF REQUEST FOR REVIEW

USPTO Customer Service Window

Attn: Mail Stop AF
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the final office action of April 9, 2007, the due date for response being extended to August 9, 2007, the Applicants submit the following arguments for consideration with the concurrently filed Pre-Appeal Brief Request for Review.

Remarks/Arguments begin on page 2 of this paper.

REMARKS/ARGUMENTS

The Examiner has rejected claims 18-19 and 35-43 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Pre-appeal brief review is appropriate, because the claims clearly produce a useful, concrete and tangible result. In the first step of independent claim 18, a plurality of voted ballots are *marked with a unique ballot identification*. In the second step, the ballots are scanned and visual representations of the ballots are generated. In the third step, markings made by the voter on the ballots are analyzed and vote data associated with each ballot is generated. Finally, in the last step, the visual representation of the ballot and the corresponding vote data is *associated with the voted ballot based on the unique ballot identification* marked in the first step. As a result, the three components (voted ballot, visual representation of ballot, and vote data corresponding to analyzed ballot) are all associated, and ready for auditing.

Accordingly, the claim does describe a method of auditing. Furthermore, the claim produces a concrete, tangible, useful result. That is, the method produces three separate components all associated with a unique ballot identification which facilitates proper auditing of ballots. The Examiner suggests that the explicit step of storing the visual representation and the vote data *in a database* would overcome the rejection, since claim 20 is not rejected under 35 U.S.C. §101. However, such a step is not required to make the claim produce a concrete, tangible and useful result. As argued above, the claim already produces such a result *in each recited step*. Claim 19 depends from claim 18 and inherits the same concrete, tangible and useful result as claim 18. Reconsideration and withdrawal of the rejection is requested.

Turning to claim 35, the Examiner suggests that the claimed computer readable medium comprises “wireless telecommunication signals and carrier waves, forms of energy.” Further, the Examiner presumably considers a “computer readable *storage* medium” to overcome such a deficiency. The Examiner’s position is clearly at odds with MPEP requirements. There is simply no requirement to claim a computer readable *storage* medium. Section 2106(IV)(b)(1)) of the MPEP states that “[w]hen functional descriptive material is recorded on some *computer readable medium* it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” Accordingly, applicants respectfully request withdrawal of the rejection. Claims 36-43 depend from claim 35, and accordingly the rejection should be withdrawn for at least the same reason.

Turning to the substantive rejections, the Examiner has rejected claims 18-43 as being obvious in view of U.S. Patent No. 6,250,548 to McClure. Pre-appeal brief review is appropriate because the Examiner’s rejection evidences a lack of understanding of the claimed invention, as well as a lack of understanding of the McClure reference, despite four written responses and an in-person demonstration of the invention during an interview.

The Examiner has applied impermissible hindsight to attempt to find the elements of claims 18-43 in the McClure patent. In the office action, the Examiner repeatedly refers to disparate sections of McClure which are relatively unrelated, namely, Column 32, lines 53-57, and Column 37, lines 22-38. McClure discussed several modes of voting. First, McClure discusses voting at a kiosk in a polling location. Next, McClure discusses absentee voting procedures. Finally, McClure discusses internet voting. The Examiner takes bits and pieces of these three types of voting described in McClure and using hindsight, attempts to find elements

of applicants' claims. This is not permissible, and would not be possible. The test is whether one of ordinary skill at the time the invention was made would read McClure and be able to make applicants' claimed invention without undue experimentation. This simply would not be possible.

Applicants' invention is directed to a method of auditing an election where *voted paper ballots* are marked with an identifier, scanned and analyzed to determine what votes were made on the ballot. Vote data is then generated based on the analyzed ballot, and the three elements are associated with one another to improve human reviewability of the voted ballots. The three elements are the voted paper ballot, the scanned electronic version of the ballot, and the vote data generated based on the analysis of the ballot. Because of this, a computer can detect errors on a particular ballot, and bring the error to the attention of a human.

The Examiner erroneously looks to the absentee voting process described in McClure, and in particular the brief mention of handwriting recognition which may occur where an absentee voter provided a "write-in" vote. The Examiner then combines this with internet voting described later in McClure for a ballot image that is "downloaded, displayed, written-in/changed, cast and stored." The Examiner fails to recognize that nowhere in McClure is auditing of voted ballots as described above and claimed, taught or suggested in McClure.

On the contrary, McClure's teaching would render the type of auditing described above *impossible*. McClure's system is meant to *prevent humans from knowing what votes were cast on a particular ballot*. This point cannot be overstated, and is why the McClure reference is poorly selected as a 103 reference by the Examiner. Embodiments of the present invention, as claimed, *enable* a human reviewer to correct vote data to more accurately reflect voters' intent based on a review of voted ballots. McClure, by contrast, specifically renders such ability *impossible* by

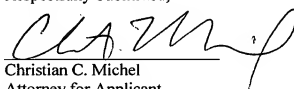
randomizing the location of ballot positions, and separating the voted markings from the associated candidates. In McClure, a computer is *required* to know what votes were made on a particular ballot, and the computer has the last word *by design*. In embodiments of the present invention, by contrast, a human being can advantageously correct what a computer otherwise got wrong.

At the December 13, 2005 interview, the Examiner appeared to appreciate the above distinctions, and agreed to withdraw the rejections based on McClure and to perform an update search for new prior art. Unfortunately, the Examiner repeated the same erroneous rejections with the same faulty logic and impermissible hindsight in the current office action. Applicants kindly ask for review of the Examiner's reasons for rejection, and for the rejection to be withdrawn.

Conclusion

In view of the above, it is believed that there are at least one or more errors or omissions in the Examiner's rejections.

Respectfully Submitted,



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